

Remarks/Arguments

Rejection Under 35 U.S.C §102(b)

The Examiner states that Claims 1, 2 and 6 are rejected under 35 U.S.C. §102(b) as being anticipated by JP 04063810A (hereinafter the JP'810 patent). Applicants traverse.

For a rejection under 35 USC §102 to be properly made and sustained, the art cited in that rejection must disclose each and every element of the claim(s) called out in the rejection.

MPEP §2131:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Specifically, the Examiner states that such patent discloses "a photoimagable composition comprising an acrylate norbornene polymer comprising units of 4,5 substituted norbornene (see claim 2 of translation) in the amount of 30-90 mol.% (second paragraph of page 8 of translation) and an acrylate monomer represented by formula (I) in claim 8 of translation in the amount as instantly claimed." The Examiner asserts that such reads on Applicants' Claims 1 and 6, and that a norbornene compound of formula (II) reads on Applicants' Claim 2.

Applicants respectfully assert that the JP'810 patent does not meet the requirement for a rejection under §102(b) as the Examiner's assertions of what the JP'810 patent discloses are incorrect.

First, the JP'810 patent NEVER refers to any of the polymeric materials disclosed therein as being "photoimagable." Rather, referring to page 6 of the translation, it is seen, in the first paragraph of that page, that the invention of the JP'810 application is directed to "molded products," in the second paragraph to molded products with excellent optical properties (a listing of such products is provided) and in the section entitled "Problems to be solved by the invention," to polymers that solve a list of problems found in polymers of each Japanese Patent Application or Patent Publication listed therein. Further, a photoimagable material is never even suggested

in JP'810 and as such a suggestion would be incongruous for a disclosure direct to moldable optical materials and structures made therefrom. Thus, for the failure of the JP'810 application to disclose, or even suggest, the claimed limitation of photoimagability (see the second word of each of instant Claims 1, 2 and 6), the JP'810 patent CANNOT anticipate any of Claims 1, 2 and 6 of the instant application, and hence for this reason alone, must be withdrawn. Such action is earnestly sought.

In addition, the Examiner's statement that the JP'810 patent discloses, referring to the second paragraph of page 8 of the translation, that the ratio of norbornene-type units of the polymer is in the range of 30 ~ 90 mol% is also incorrect. This paragraph does NOT refer to norbornene-type units, but rather refers to constituent unit (i), which is the acrylate unit of the JP'810 polymer.

Referring to the last complete paragraph in page 9 of the translation of JP'810, it can be seen that the JP'810 patent teaches that the norbornene-type constituent, referred to therein as constituent (ii), should be confined to a range of 0.5 ~ 3.5 mol%. Therefore, Applicants respectfully assert then that as Claims 1 and 6 of the instant application explicitly recite a range of from 10 to 85 mole % for the norbornene-type unit, it is seen that the JP'810 patent CANNOT, for this second reason, anticipate either of Claims 1 and 6, or Claim 2 which depends from Claim 1.

Having shown that the JP'810 patent does not meet the requirement of a rejection under §102(b) for the above two reasons, Applicants respectfully request that the rejection of Claims 1, 2 and 6 under §102(b) be withdrawn. Such action is earnestly sought.

Rejection Under 35 U.S.C §103(a)

Kaimoto in view of JP'810

Claims 3, 8-9 and 12-25 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kaimoto et al., (U.S. 5,585,219) in view of JP'810. Applicants traverse.

It should be noted that while the Examiner states that Claims 12-25 are rejected in paragraph 5 of the Action, Applicants submit that the instant application is limited to only 16 claims as indicated at line 4 of the Office Action Summary. Therefore,

Applicants will limit all remarks hereinafter to the 16 pending claims of the application and within this specific section, to Claims 3, 8-9 and 12-16; further Applicants respectfully assert that such a limitation is proper and that this response, so limited, is complete and timely filed. Further, it is noted that Claim 3 depends from Claim 2 and through Claim 2 from Claim 1. Claim 8 is an independent claim from which Claims 9 and 12 depend directly and indirectly, respectively; and that Claim 13 is also an independent claim from which Claims 14-16 depend directly or indirectly therefrom. Hence Applicants will further limit the response to this rejection to the independent claims from which the rejected claims depend.

Turning first to Claim 1 from which Claim 3 depends, such claim does not stand rejected under §103. Since Claim 1 is broader in scope than Claim 3, Applicant respectfully asserts that the rejection of Claim 3 MUST be in error as it is not possible for the more limited, dependent claim, to be read on by the cited art.

Notwithstanding the above, and now also referring to Claims 8-9 and 12-16, it has been shown in Applicants' response to the rejection under §102(b), paragraph 4 of the Action, that JP'810 pertains to molded articles and polymeric materials for such molded articles. Therefore, it is irrefutable that JP'810 relates to art that is in a different field of endeavor than either the instant invention, as recited in Claims 1-16, or Kaimoto, since both are directed to photoresist compositions and polymeric materials for such compositions.

Referring to M.P.E.P. §2141.01(a) it is stated that:

In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. *In re Oetiker*, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

In *In re Clay*, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992), "reasonably pertinent" is defined as follows:

A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem.

and further, ibid. that:

where the general scope of a reference is outside the pertinent field of endeavor, the reference may be considered analogous art if subject matter disclosed therein is relevant to the particular problem with which the inventor is involved

Applicants respectfully assert that this difference in the field of art to which JP'810 and Kaimoto are each directed is particularly telling as it prevents the combination of such art in the manner suggested by the Examiner absent a showing by the Examiner that either of the two exceptions to the holding of In re Oetiker, as provided for in In re Clay, apply to the instant rejection. This has NOT been done; therefore, Applicants assert that as the Examiner has not met the burden required by In re Oetiker, and thus it MUST be found that Kaimoto and JP'810, not being of related fields of endeavor, pertinent or analogous, CANNOT be the basis of the rejection under §103 as alleged by the Examiner, and that the rejection of Claims 3, 8-9 and 12-16 MUST be withdrawn.

Notwithstanding the aforementioned failure to meet the burden of proof for this combination of art in unrelated fields of endeavor, should the Examiner seek to assert that such art is relevant, pertinent or analogous, Applicants respectfully request that such argument for relevance, pertinence or analogy provide for the fact that the invention of Kaimoto is directed to solving problems completely different than the problems the invention of 'JP810 is directed to.

Furthermore, Applicants provided, in their April 14, 2005 response, argument to the effect that the substitutions of electron withdrawing groups at the 2 position of the norbornene-type structures in Kaimoto are necessary for the polymerization method taught therein to occur. This argument, has not been refuted by the Examiner, and thus MUST now be accepted as factual. Therefore, even if, arguendo, JP'810 and Kaimoto were directed to the same field of endeavor, the specific combination of that art suggested by the Examiner would NOT have any chance of success. Thus for each of the reasons present above, either singly or in any combination thereof, Applicants respectfully assert that the rejection of Claims 3, 8-9 and 12-16 is INCORRECT and MUST be withdrawn. Action to that effect is earnestly sought.

Kaimoto in view of Sen et al (U.S. 6,111,041)

The Examiner states that Claims 10 and 11 are rejected under 35 U.S.C. §103(a) as being unpatentable over Kaimoto in view of Sen et al., (U.S. 6,111,041). Applicants traverse.

This rejection was presented in the Examiner's previous Action, mailed November 12, 2004, at paragraph 8. In Applicants' response to that Action, mailed April 14, 2005, such rejection was traversed where such traversal was accompanied by a complete and timely made argument. However, the current Action makes no mention of Applicants' traversal to this rejection being considered and if so, why it was not found persuasive. Rather, it appears that the Examiner merely restated the identical rejection for a second time, without comment.

Therefore Applicants, believing that their previous response was not appropriately considered, reassert that argument by reference thereto and respectfully request that such argument be considered herein and if not found persuasive, a reason for such a failing be provided as is customary and proper (See, M.P.E.P. §707.07(f)).

Kaimoto in view of Rhodes et al (U.S. 6,232,417)

The Examiner states that Claims 4-7 and 12 are rejected under 35 U.S.C. §103(a) as being unpatentable over JP'810 in view of Kaimoto and further in view of Rhodes et al (U.S. 6,232,417). Applicants traverse.

This rejection is analogous to the rejection of the same claims in paragraph 9 of the aforementioned previous Action differing primarily in that newly cited JP'810 has been combined with Kaimoto. For example, where in the previous Action the Examiner, referring to Claim 4 of the instant application, stated that "Kaimoto does not disclose the presence of one of dissolution rate modifier, quencher or sensitizer," the current action is changed only to reflect that "JP'810 and Kaimoto do not disclose the presence of one of dissolution rate modifier, quencher or sensitizer." The balance of the Examiner's comments regarding Claim 4 seeming to be identical in both Actions.

As previously pointed out, JP'810 is directed to producing molded articles and the polymeric materials used for forming such molded articles. Thus while it might be expected that a reference discussing a photoresist composition, such as Kiamoto, might be expected to disclose or suggest such composition additives as a dissolution

rate modifier, quencher or sensitizer, that JP'810 also does not provide such a disclosure is to be expected as none of such additives are appropriate to the producing of molded articles and/or the polymeric materials used for forming such molded articles.

Therefore, Applicants believe that a proper response to the instant rejection is to direct the Examiner's attention to the Applicants' Non-Analogous Art argument presented on pages 12 and 13 of this response and to incorporate it herein by reference. In view of this argument, it should be clear that JP'810 is improperly used in the instant rejection and that the only proper response to this rejection is to treat the rejection as if it was made without reference to JP'810. Considering the instant rejection in that manner, it becomes essentially identical to the rejection presented in paragraph 9 of the aforementioned previous Action. Since the current Action makes no mention of Applicants' traversal to this rejection being considered and if so, why it was not found persuasive, Applicants, believing that their previous response was not appropriately considered, reassert that argument by reference thereto and respectfully request that such argument be considered herein and if not found persuasive, a reason for such a failing be provided as is customary and proper (See, M.P.E.P. §707.07(f)).

Summary

In summary Applicants respectfully requests reconsideration of the rejections of Claims 1-16 in view of the remarks/argument presented above or by reference to their previous response. Applicants believe such claims are in condition for allowance, such action is requested. Should, however, the next action be anything other than a Notice of Allowance, Applicant invites the Examiner to contact Bernard Berman, Esq. at the telephone number noted below prior to filing such an action in an effort to expedite this prosecution.

Respectfully submitted,

Dated: Nov. 17, 2005

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